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09/944,610	08/31/2001	Toshiya Yoshimune	11342.00007	2396

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT PAPER NUMBER

2136

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/944,610

Applicant(s)

YOSHIMUNE ET AL.

Examiner

Pramila Parthasarathy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,12-14 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,12-14 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/905,655.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/07/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the communication filed on January 07, 2004.  
Preliminary amendments to the Claims were filed on August 31, 2001. Claims 1, 12 and 20 were amended. Claims 2 – 11 and 15 – 19 were cancelled. Therefore, presently Claims 1 – 9 are pending.

### ***Claim Objections***

2. Claims 1 and 20 are objected to because of the following informalities:  
Claim 1 recites "A book .... a broadcasting facility for broadcasting all the book data stored and managed by the data center computer according to cg. ...". Replace "cg." with "a".
3. Claim 20 recites "A method for providing a book .... selectively storing and managing the book data on a user terminal side by a user terminal computer of the user terminal; ...". Replace with "selective storing and managing the book data on a user terminal side by a user computer of the user terminal;"

Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 6 – 10 and 20 of the copending application No. 09/531,058, hereinafter '058 contain every element of Claims 1, 12 – 14 and 20 of the instant application No. 09/944,610, hereinafter '610, and as such anticipate(s) Claims 1, 12 – 14 and 20 of the instant application.

8. Claims 1, 12 – 14 and 20 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 6 – 10 and 20 of copending Application No. 09/531,058. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

9. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

10. The following list of Claims in '058 are teaching in the copending application '610:

<u>'610</u>	<u>'058</u>
1, 12 – 14, 20	1, 6 – 10, 20

In detail:

11. Regarding Claim 1 as exemplary in '610 and Claim 1 and 8 in '058, recite a book data service system, comprising:

“at least one data center including:

a data center computer for storing and managing book data available in the book data service system;” in '610

“at least one data center including:

a data center computer for storing and managing book data available in the book data service system;” in '058

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“a broadcasting facility data for broadcasting all the book data stored and managed by the data center computer according to a prescribed communication protocol, without requiring any requests from users, the prescribed communication protocol being based on prescribed synchronization control and error correction scheme for realizing data delivery by broadcasting the book data without a confirmation signal;” in ‘610

**“a broadcasting facility for broadcasting all the book data stored and managed by the data center computer according to a prescribed communication protocol, without requiring any requests from users, the prescribed communication protocol being based on prescribed synchronization control and error correction scheme for realizing data delivery by broadcasting the book data without a confirmation signal;” in ‘058**

“a plurality of user terminals, each user terminal including:  
a broadcast receiver for receiving the book data broadcasted from the broadcasting facility of the data center; a user terminal computer for selectively storing and managing the book data received by the broadcast receiver; and a display device for displaying the book data selectively stored and managed by the user terminal computer;” in ‘610

**“a plurality of user terminals, each user terminal including:  
a broadcast receiver for receiving the book data broadcasted from the broadcasting facility of the data center; a user terminal computer for selectively storing and managing the book data received by the broadcast receiver; and a**

**display device for displaying the book data selectively stored and managed by the user terminal computer;"** in '058

"wherein the book center further includes a data center side communication device for enabling one-to-one communication with each user terminal through a communication network, a remote record Inspection unit for inspecting a book data service utilization record at each user terminal through the data center side communication device, and a charging unit for charging said each user terminal according to the book data service utilization record Inspected by the remote record inspection unit." in '610

"wherein the data center further includes a data center side communication device for enabling one-to-one communication with each user terminal through a communication network, a returning unit for returning a key for deciphering the enciphered book data broadcasted by the broadcasting facility through the data center side communication device to the user terminal which requested the key, and a charging unit for charging said each user terminal which requested the key." in '058 and "wherein the charging unit charges a user using the user terminal every time the user terminal requests the key." in '058

12. "The exemplary Claim 1 in '610 is generic to the species of invention covered by Claims 1 and 8 of the copending application. Thus, the generic invention is **"anticipated"** by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4 . This court's predecessor has

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held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In *re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982), *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness- type double patenting."

(*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993).

13. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 12 – 14 and 20 are rejected under 35 U.S.C. 102(e) as being unpatentable over Sprague et al. (U.S. Patent Number 5,247,575, hereafter "Sprague").



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15. Regarding Claim 1, Sprague discloses a book data service system, comprising:  
at least one data center including: a data center computer for storing and managing book data available in the book data service system (Sprague Column 4 lines 44 – 67); and

a broadcasting facility for broadcasting all the book data stored and center computer according to a prescribed communication protocol, without requiring any requests from users, the prescribed communication protocol being based on prescribed synchronization control and error correction scheme for realizing data delivery by broadcasting the book data without a confirmation signal (Sprague Column 9 lines 21 – 50 and Column 13 lines 1 - 10); and

a plurality of user terminals, each user terminal including: a broadcast receiver for receiving the book data broadcasted from the broadcasting facility of the data center (Sprague Column 1 lines 34 – 38 and Column 5 lines 45 – 60);

a user terminal computer for selectively storing and managing the book data received by the broadcast receiver (Sprague Fig. 1, #30 and Column 10 lines 41 – 60); and

a display device for displaying the book data selectively stored and managed by the user terminal computer (Sprague Column 10 lines 41 – 60);

wherein the book center further includes a data center side communication device for enabling one-to-one communication with each user terminal through a communication network (Sprague Column 3 lines 40 – 45, Column 12 lines 1 – 16, and Column 13 lines 41 – 55), a remote record inspection unit for inspecting a book data service utilization record at each user terminal through the data center side communication device (Sprague Column 4 lines 61 – 68 and Column 13 lines 29 – 38), and a charging unit for charging said each user terminal according to the book data service utilization record inspected by the remote record inspection unit (Sprague Column 13 lines 41 – 55 and Column 12 lines 1 – 17).

16. Regarding Claim 20, Sprague discloses a method for providing a book data service, comprising the steps of:

storing and managing book data available in the book data service on a data center side by a data center computer of a data center(Sprague Column 4 lines 44 – 67);

broadcasting all the book data stored and managed by the data center computer according to a prescribed communication protocol, without requiring any requests from users, the prescribed communication protocol being based on prescribed synchronization control and error correction scheme for realizing data delivery by broadcasting the book data without a confirmation signal (Sprague Column 9 lines 21 – 50 and Column 13 lines 1 - 10);

receiving the book data broadcasted from the data center at a user terminal (Sprague Column 17 lines 23 – 31);

selectively storing and managing the book data on a user terminal side by a user terminal computer Of the user terminal (Sprague Column 18 line 62 – Column 19 line 14);

displaying the book data selectively stored and managed by the user terminal computer on a display in an image of a book (Sprague Column 19 lines 17 – 26 and Column 20 lines 31 – 33);

inspecting a book data service utilization record at each user terminal from a remote record inspection unit of the data center using a data center side communication

device of the data center for enabling one-to-one communication with each user terminal through a communication network (Sprague Column 4 lines 61 – 68 and Column 13 lines 29 – 38); and

charging said each user terminal from the data center according to the book data service utilization record inspected by the remote record inspection unit (Sprague Column 13 lines 41 – 55 and Column 12 lines 1 – 17).

17. Regarding Claim 12, Sprague discloses the book data service system of claim 1, wherein: each user terminal further includes a user terminal side communication device for enabling one-to-one communication with the data center through the communication network (Sprague Column 4 lines 61 – 68 and Column 13 lines 29 – 38), an inspection unit for inspecting whether the book data stored by the user terminal computer and selected by a user is enciphered or not (Sprague Column 4 lines 61 – 68 and Column 13 lines 29 – 45), and a deciphering request unit for requesting a deciphering of enciphered book data to be user terminal side communication device when the inspection unit finds the enciphered book data and obtaining deciphered book data from the user terminal side communication unit (Sprague Column 13 lines 29 – 45); and

the user terminal side communication device contains a communicating unit for making one-to-one communication with the data center through the communication network (Sprague Column 11 lines 61 – 68, Column 12 lines 1 – 16 and Column 13 lines 29 – 45), a deciphering unit for deciphering the enciphered book data requested by the deciphering request unit and returning the deciphered book data to the deciphering

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request unit, a recording unit for recording the book data service utilization record whenever the deciphering unit deciphers the enciphered book data (Sprague Column 13 lines 26 – 59), and a returning unit for returning the book data service utilization record recorded by the recording unit through the communicating unit to the remote record inspection unit (Sprague Column 14 line 49 – Column 15 line 22).

**18.** Claim 13 is rejected as applied about in rejecting Claim 14. Furthermore, Sprague discloses the book data service system wherein the recording means records the book data service utilization record in terms of at least one of a time in use of the deciphering means, an amount of data deciphered by the deciphering means, and a number of cases deciphered by the deciphering means (Sprague Column 16 line 39 – Column 17 line 3).

**19.** Claim 14 is rejected as applied about in rejecting Claim 14. Furthermore, Sprague discloses the book data service system wherein the recording means records the book data service utilization record according to a book code of each book data deciphered by the deciphering means, so as not to change the book data service utilization record in a case of re-deciphering of once deciphered book data indicated by the book code (Sprague Column 4 lines 9 – 68 and Column 16 line 39 – Column 17 line 3).

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on Tuesday – Thursday 8:00a.m. To 3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
April 02, 2005.

  
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